



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/646,536

08/21/2003

Yuh-Shen Song

7443-102

9859

167

7590

12/12/2006

FULBRIGHT AND JAWORSKI LLP  
555 S. FLOWER STREET, 41ST FLOOR  
LOS ANGELES, CA 90071

EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3691

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/646,536

Applicant(s)

SONG ET AL.

Examiner

Lalita M. Hamilton

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>advisory action</u> .                  |

## **DETAILED ACTION**

### **Summary**

On August 16, 2006, a final office action was sent to the Applicant rejecting claims 1-45. On November 16, 2006, the Applicant responded with a Request for Reconsideration. Prosecution has been reopened, and a non-final follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 7-8, 11-12, 16-17, 20-23, 27-41, and 44-45 are rejected under 35 U.S.C. 102(a) as being anticipated by March (2001/0016763).

March discloses a method for transferring funds comprising a method for verification and processing of a remote transaction using cash as the payment instrument involving a payer's account at a financial institution, opening a remote payment system account for the payer after verifying the payer's identity, payer's financial institution and the specific account at that institution, authenticating the payer's identity when the payer logs into the remote payment system to conduct a remote transaction using cash as the payment instrument, prompting the payer to enter the payee's name, identification information, and transaction amount into the database of the remote payment system; assigning a transaction identification number which the payee will use to identify and request a cash payment, prompting the payee to insert a

machine-readable official identification card and enter the assigned transaction identification number into a remote payment system terminal, verifying that embedded identification information read from the payee's official identification card at the remote payment system terminal matches the payee information entered by the payer into the remote payment system database and associated with the transaction identification number entered by the payee, and that the specific amount of funds is available from the payer's account at the financial institution, and if the verification of the payee's identity is successful and the specific amount of transaction funds are available, causing said remote payment terminal to issue a cash payment of that specific amount to the payee (p.3, 41-43 and p.4, 53 to p.5, 60); prompting the payer to submit a machine-readable official identification card prior to the opening of said remote payment system account, and opening said the remote payment system account only if embedded identification information read from the payer's identification card matches the account holder information of the financial account identified by the payer (p.3, 41-43 and p.4, 53 to p.5, 60); prompting the payer to input an additional item of personal information embedded in the identification card (PIN) but not stored in the remote database of the financial institution, and verifying that the additional personal information input by the payer matches the personal information embedded in the identification card (p.3, 41-43 and p.4, 53 to p.5, 60); prompting the payer to log into the remote payment system with an official identification card, and validating the login only if the embedded identification information read from the payer's identification card matches the account holder information in the remote payment system database (p.3, 41-43 and p.4, 53 to p.5, 60);

Art Unit: 3691

the personal information input by the payee includes at least a password (p.3, 41-43 and p.4, 53 to p.5, 60); the payer's financial account includes at least a bank account such as checking or savings account (p.3, 41-43 and p.4, 53 to p.5, 60); the payer's financial account includes at least a credit card account (p.3, 41-43 and p.4, 53 to p.5, 60); the payer's financial account includes at least a debit card account (p.3, 41-43 and p.4, 53 to p.5, 60); the remote payment system terminal is incorporated into a self-service machine (p.3, 41-43 and p.4, 53 to p.5, 60); the self-service machine includes at least an ATM terminal (p.3, 41-43 and p.4, 53 to p.5, 60); the self-service machine includes at least a check-cashing terminal (p.3, 41-43 and p.4, 53 to p.5, 60); the self-service machine includes at least a standalone kiosk where cash is available for withdrawal (p.3, 41-43 and p.4, 53 to p.5, 60); the remote payment terminal is installed in a location under the supervision and control of the remote payment system (p.3, 41-43 and p.4, 53 to p.5, 60); the remote payment system secures the payment funds from the specified payer account against the possible payer's fraud before issuing the transaction identification number (p.3, 41-43 and p.4, 53 to p.5, 60); permitting the payer's financial institution to open an account in the remote payment system on behalf of the payer (p.3, 41-43 and p.4, 53 to p.5, 60); the payer's account in the remote payment system is linked to a specific payer's account of the financial institution opening said remote payment system account (p.3, 41-43 and p.4, 53 to p.5, 60); the remote payment system is established exclusively for one financial institution to provide services to the customers of the financial institution (p.3, 41-43 and p.4, 53 to p.5, 60); a wireless data transmission device is incorporated into the identification card and a

Art Unit: 3691

wireless data receiver reads the machine-readable identification information of the identification card (p.3, 41-43 and p.4, 53 to p.5, 60); a wireless data transmission device is incorporated into the identification card and a wireless data receiver reads the machine-readable identification information of the identification card (p.3, 41-43 and p.4, 53 to p.5, 60); a wireless data transmission device is incorporated into the identification card and a wireless data receiver reads the machine-readable identification information of the identification card (p.3, 41-43 and p.4, 53 to p.5, 60); prompting the payer to input an additional item of personal information not embedded in the identification card but stored in the remote database of the financial institution, and verifying that the additional personal information input by the payer matches the personal information stored in the remote database (p.3, 41-43 and p.4, 53 to p.5, 60); and the payee does not have an account with the remote payment system and the card is not linked to any account at a financial institution (p.3, 41-43 and p.4, 53 to p.5, 60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 9-10, 13-15, 18-19, and 24-26, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over March in view of Reece (2003/0150915).

March discloses the invention substantially as claimed; however, March does not disclose the personal information input by the payer includes at least part of a social

Art Unit: 3691

security number; the personal information input by the payer includes at least biometric information; the biometric information input by the payer includes at least a fingerprint; the card is a government issued identification card being a driver's license; or including an escrow agent into the transaction based on the agreement between payer and payee, and the payee cannot receive pay. Reece discloses an IC authorization method the personal information input by the payer includes at least part of a social security number (p.10, 274-297 and p.11, 314-328); the personal information input by the payer includes at least biometric information (p.10, 274-297 and p.11, 314-328); the biometric information input by the payer includes at least a fingerprint (p.10, 274-297 and p.11, 314-328); the card is a government issued identification card being a driver's license (p.10, 274-297 and p.11, 314-328); and including an escrow agent into the transaction based on the agreement between payer and payee (p.10, 274-297 and p.11, 314-328). It would have been obvious to one having ordinary skill in the art at the time the invention was made to the personal information input by the payer includes at least part of a social security number; the personal information input by the payer includes at least biometric information; the biometric information input by the payer includes at least a fingerprint; the card is a government issued identification card being a driver's license; including an escrow agent into the transaction based on the agreement between payer and payee, and the payee's official identification card is not linked to any account at any financial institution, as taught by Reece into the invention disclosed by March, to provide additional alternatives of verifying identity to protect accounts against theft.

***Response to Arguments***

Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lalita M. Hamilton  
Primary Examiner, 3691



**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/646,536

Applicant(s)

SONG ET AL.

Examiner

Lalita M. Hamilton

Art Unit

3691.

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

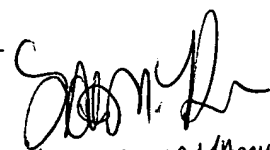
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☒ Other: See Continuation Sheet.

  
LALITA M. HAMILTON  
PRIMARY EXAMINER, 3691

Continuation of 13. Other: The Examiner has considered the request for reconsideration. Prosecution has been reopened..

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke extending to the right.